

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket Number 15143US01

In re Application of:)	
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)	Electronically Filed
Serial No.: 10/824,897)	
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Filing Date: 4/15/04)	
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Examiner: Roberts)	
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Confirmation No.: 7572)	
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Art Unit No. 2621)	
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PREAPPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This amendment is filed in response to the Final Office
Action mailed 06/2/2009.

REMARKS

Claims 1, 2, and 4-10 are presently pending and stand rejected.

Claims 1, 2, and 4 were rejected under 35 U.S.C. § 103(a) as being obvious from the combination of Fimoff in view of Yuan and further in view of AAPA.

Claim 1 recites, among other limitations, "a frame buffer for storing past and future reference pictures" and "said pixel reconstructor further comprising: a macroblock input buffer for storing the reference pixels that are fetched from a frame buffer by the video request manager at the addresses calculated by the motion vector address computer; and a register for storing a portion of the reference pixels that are fetched from the frame buffer by the video request manager at the addresses calculated by the motion vector address computer" and "wherein the register, macroblock input buffer, and frame buffers are separate".

Examiner has indicated that "Fimoff (modified by Yuan) as a whole is silent in regards to register for storing a portion of the reference pixels that are fetched from the frame buffer by the video request manager at the addresses from the frame buffer that were calculated by the motion vector address computer" Office Action at 5. However, Examiner has indicated that the foregoing is taught in application, 0007. Id. Assignee respectfully traverses and submits that AAPA does not teach "a register for storing a portion of the reference pixels ...".

Accordingly, for at least this reason, Assignee respectfully requests withdrawal of the rejection to independent claims 1 and 5, as well as to dependent claims 2, 4, 6-10.

Furthermore, in regards to claim 1, Examiner has conceded that Fimoff (modified by Yuan and AAPA):

"still fails to teach wherein the register, macroblock input buffer, and frame buffers are separate. However, it would have been an obvious modification readily apparent to one of ordinary skill in the art at the time of the invention since it entails to separate the register, macroblock input buffer, and frame buffers, which is merely to make separable, a distinction which the courts have already ruled against *Nerwin v. Erlichman*, 168 USPQ 177, 1179 (PTO Bd. Of Int. 1969).

Assignee respectfully submits that the foregoing application of the alleged holding *Nerwin* is an error of law. The Board of Patent Appeals and Interferences has rejected the foregoing reasoning involving *Nerwin* on several occasions.

In *Ex Parte Holmes*, Examiner held that "Such a distinction is not patentably distinguishing, since it has held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179." *Ex Parte Holmes*, 96-3077 (BPAI 1999). The BPAI responded that "We have reviewed the *Nerwin* decision cited by the Examiner and find that it does not support the Examiner's position." *Id.*

In *Ex Parte Gruden*, the BPAI stated that:

The examiner's reliance on and citation of *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Bd.Pat.Int. 1969), which according to the examiner held that 'constructing a formerly integral structure in various elements involves only routine skill in

the art,' appears to us to be misplaced. We find no such 'holding' in *Nerwin v. Erlichman*. The only statement in that case which we think may be referred to by the examiner is one which indicates that '[t]he mere fact that a given structure is integral does not preclude its consisting of various elements.' This statement, in our view, is a construction of the term 'integral', and does not appear to stand for the proposition the examiner now urges.

Ex Parte Gruden, 97-1147 (BPAI 1998).

In *Ex Parte Pennell*, the BPAI noted that:

We cannot agree that *Nerwin v. Erlichman*, 168 USPQ 177 (BPAI 1969), provides the necessary rational underpinning to support the conclusion that it would have been an obvious matter of design choice to modify Rozenkranc to provide a separate trimming assembly, including the blade carrier, trim blade and trim guard, attached as one unitary piece to the housing."

Ex Parte Pennell, 2009-005025 (BPAI 2009).

Finally, the BPAI in *Ex Parte Bozmoski* noted:

that the Answer on page 6 includes a discussion of whether it would have been obvious to split the reaction block disclosed in Potts into two pieces. The Examiner cites an old Board of Interferences case, *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Bd. Pat. App. & Int. 1969). As far as we can determine, the Examiner has cited this case for the proposition that '[t]he mere fact that a given structure is integral does not preclude it consisting of various elements.' *Id.* In our view this statement reflects a discredited per se rule for obviousness and cannot be relied upon as support in this obviousness rejection."

Ex Parte Bozmoski, 2008-0092 (BPAI 2008) (Emphasis Added).

CONCLUSION

For at least the foregoing reasons, Assignee respectfully submits that each of the pending claims are

allowable and Examiner is respectfully requested to pass this case to issuance. The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: October 2, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'MDL', is written over a solid horizontal line.

Mirut Dalal

Reg. No. 44,052

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